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Paper No.

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In re Application of :
Joseph P. Errico et al. :
Application No. 10/784,598 : DECISION ON RENEWED PETITION
Filing Date: October 12, 2004 : UNDER 37 C.F.R. § 1.78(A)(3)
Attorney Docket No.: SPINE 3.0- :
437 :
Title: INSTRUMENTATION FOR :
REPOSITIONING AND EXTRACTING AN :
ARTIFICIAL INTERVERTEBRAL DISC :
FROM AN INTERVERTEBRAL SPACE :

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.78(a)(3), filed January 13, 2010 to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the Supplemental Application Data Sheet (ADS) filed concurrently with this renewed petition.

The renewed petition is **DISMISSED AS MOOT.**

A petition for acceptance of a claim for late priority under 37 C.F.R. § 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 C.F.R. 1.78(a)(2)(ii). In addition, the petition under 37 C.F.R. 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and

- (3) a statement that the entire delay between the date the claim was due under 37 C.F.R. 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

An original petition pursuant to 37 C.F.R. § 1.78(a)(3) was filed on January 13, 2009, and was dismissed via the mailing of a decision on September 8, 2009, as the concurrently submitted supplemental Application Data Sheet (ADS) was neither titled as such or executed.

With this renewed petition, Petitioner has submitted a properly titled and executed Supplemental Application Data Sheet. However, it is controlling that a review of the "Domestic Priority Information" which appears on the third page of the Supplemental Application Data Sheet indicates that Petitioner does not seek to modify the relationship of the present application with the application to which it claims the direct benefit of - it is the relationship of each preceding application which he seeks to modify (there are ten preceding applications; each is a continuation of the application which precedes it, and Petitioner seeks to change each relationship to a continuation-in-part).

Where an application claims a benefit under 35 U.S.C. 120 of a chain of applications, the application must make a reference to the first (earliest) application and every intermediate application. See Sampson v. Ampex Corp., 463 F.2d 1042, 1044-45, 174 USPQ 417, 418-19 (2d Cir. 1972); Sticker Indus. Supply Corp. v. Blaw-Knox Co., 405 F.2d 90, 93, 160 USPQ 177, 179 (7th Cir. 1968); Hovlid v. Asari, 305 F.2d 747, 751, 134 USPQ 162, 165 (9th Cir. 1962). See also MPEP § 201.11. In addition, every intermediate application must also make a reference to the first (earliest) application and every application after the first application and before such intermediate application. MPEP § 201.06(d).

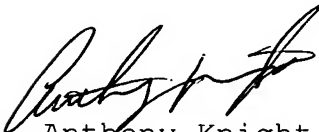
Modifying the relationships of the preceding applications in the Supplemental Application Data Sheet that is present in the present application will have no effect on any of the preceding applications - Petitioner must correct the benefit claim in each preceding application.

No petition under 37 CFR 1.78(a)(3) or surcharge is required when the applicant is changing the relationship in a benefit claim

from "continuation" (or "divisional") to "continuation-in-part" or from "continuation-in-part" to "continuation" (or "divisional"), or from "continuation" to "divisional", because the Office was able to schedule the application for publication with the relationship given. Therefore, **Petitioner should file a certificate of correction in each of the preceding applications which have matured into U.S. patents. For application numbers 10/175,417 and 10/140,153 which have gone abandoned, Petitioner will need to revive these applications so as to correct the benefit claim relationship via the filing of an amendment in each application.**

As the petition was not required, it will be dismissed as moot. As such, the \$1,4100.00 petition fee submitted on January 13, 2009 is unnecessary and will be refunded to Petitioner's Deposit Account in due course.

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.¹ All other inquiries concerning examination procedures should be directed to the Technology Center.



Anthony Knight
Supervisor
Office of Petitions

¹ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.